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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/754,369	01/09/2004	Laura Taylor	TAYL-01000US0	7596

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EXAMINER

MANAHAN, TODD E

ART UNIT PAPER NUMBER

3732

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/754,369

Applicant(s)

TAYLOR, LAURA

Examiner

Todd E. Manahan

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 jan 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: the mirror or reflective member. The claim recites the base having a slot "to receive a reflective member", thus only functionally reciting the reflective member. The reflective member is not set forth as an element of the invention. With out a reflective member, the claimed invention cannot function as a mirror.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3732

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6 and 9-11 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kelly, (United States Patent Publication No. 2004/0003825).

Kelly discloses a cosmetic mirror for affixing to a portion of a cosmetics carrier 14a comprising a base 14 having an aperture formed at least partially therethrough, the aperture having a shape customized to fit and receive the portion of the cosmetics carrier 14a, and a cover 20 pivotally mounted to the base and having a surface 22 including a reflective material thereon. The cover is hinged to the base for pivoting between a closed position where the reflective material is enclosed between the base and cover, and an open position where the reflective material is not enclosed between the base and cover. The cosmetic mirror is “capable of being detached from a first cosmetics carrier and reused with a second cosmetics carrier”. A mechanical mechanism biases the cover in the closed position and comprises a first magnet 26 mounted the base and a second magnet 28 mounted in the cover. The hinge, base and cover are made of paper or light cardboard.

Claims 1, 2, 4, 5, and 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Conley, Jr. (United States Patent No. 5,715,848).

Conley, Jr. discloses a cosmetic mirror for affixing to a portion of a cosmetics carrier 22 comprising a base 12 having an aperture 18 formed at least partially therethrough, the aperture having a shape customized to fit and receive the portion of the cosmetics carrier 22, and a cover

Art Unit: 3732

43 pivotally mounted to the base and having a surface 42 including a reflective material thereon.

The cover is hinged to the base for pivoting between a closed position where the reflective material is enclosed between the base and cover, and an open position where the reflective material is not enclosed between the base and cover. The cosmetic mirror is “capable of being detached from a first cosmetics carrier and reused with a second cosmetics carrier”. A mechanical mechanism 46 is provided to bias the cover in a closed position.

Claims 12, 13, and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Darvie (United States Patent No. 2,771,083).

Darvie discloses a cosmetic mirror for affixing to a portion of a cosmetics carrier 49 comprising a base 11 including an aperture formed at least partially through the base, the aperture having a shape customized to fit and receive the portion of the cosmetics carrier 49, and a slot 25 formed at least partially through the base, the slot receiving a reflective member 26 capable of being housed within the slot and withdrawn from the slot. The cosmetic mirror is “capable of being detached from a first cosmetics carrier and reused with a second cosmetics carrier”.

Claims 12, 13, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Loy (United States Patent No. 2,771,083).

Loy discloses a cosmetic mirror for affixing to a portion of a cosmetics carrier 19 comprising a base 16 including an aperture formed at least partially through the base, the aperture having a shape customized to fit and receive the portion of the cosmetics carrier 19, and a slot formed at least partially through the base, the slot receiving a reflective member 28 capable

of being housed within the slot and withdrawn from the slot. The cosmetic mirror is “capable of being detached from a first cosmetics carrier and reused with a second cosmetics carrier”.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Conley, Jr. in view of Kelly.

To replace the mechanical mechanism biasing the cover closed on the device of Conley, Jr. with first and second magnets in view of Kelly would have been obvious to one skilled in the art as such would be nothing more than substitution of functionally equivalent structures in the art.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Conley, Jr.

Conley, Jr. discloses the claimed invention except for the base and cover formed at least partially of cardboard covered with paper. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the base and cover at least partially of cardboard covered with paper, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Darvie in view of Kelly.

To replace the mechanical mechanism biasing the cover closed on the device of Conley, Jr. with first and second magnets in view of Kelly would have been obvious to one skilled in the art as such would be nothing more than substitution of functionally equivalent structures in the art.

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darvie.

Darvie discloses the claimed invention except for the base and cover formed at least partially of cardboard covered with paper or at least partially of plastic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the base and cover at least partially of cardboard covered with paper or at least partially of plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd E. Manahan whose telephone number is 571 272- 4713. The examiner can normally be reached on Mon-Fri.

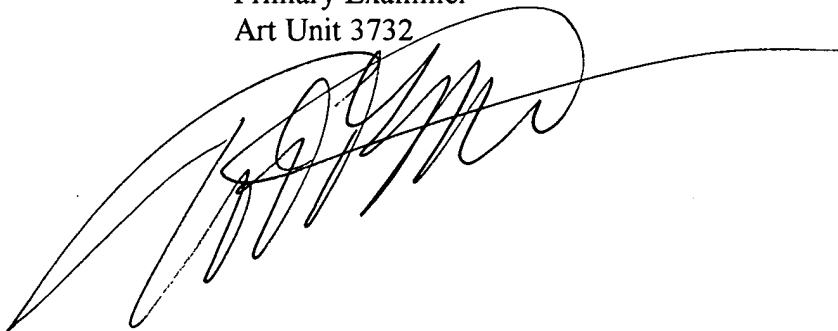
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 571 273-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3732

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Todd E. Manahan
Primary Examiner
Art Unit 3732

T.E. Manahan
8 June 2005

A handwritten signature in black ink, appearing to read 'T.E. Manahan', is written over the printed name and title. The signature is stylized with a large, sweeping initial 'T' and a long horizontal line extending to the right.